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09/989,567	11/19/2001	Carla Arlene Turner		1189

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Carla Arlene Turner  
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EXAMINER

VANATTA, AMY B

ART UNIT PAPER NUMBER

3765

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/989,567

Applicant(s)

TURNER, CARLA ARLENE

Examiner

Amy B. Vanatta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment to the claims filed on 11/25/02 is not properly made and does not comply with the requirements of 37 CFR 1.121(c) because it does not indicate changes made in the claims with brackets indicating deletions and underlining indicating insertions. This amendment will be accepted, however, in order to further prosecution of the application since applicant is a *pro se* applicant and is unfamiliar with proper prosecution procedure. Applicant should make all reasonable efforts in the future, however, to ensure that any other amendments to the claims are made in accordance with 37 CFR 1.121(c).

### ***Specification***

2. The title of the invention, "TE (Turner Ensemble) by Vito", is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, for example, "Combination Jacket and Tote Bag" or "Convertible Jacket and Tote Bag".
3. The substitute specification filed 11/25/02 has not been entered because it does not conform to 37 CFR 1.125(b)(2) because the marked up copy of the originally filed specification does show not show all matter being added and all matter being deleted. A copy of the original specification should show matter being deleted as indicated by brackets and the matter being added as indicated by underlining. The brackets and

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underlining should be shown on the same copy of the original specification so as to allow a comparison of the original and amended specifications.

4. Applicant is reminded that the substitute specification must not add any new matter to the originally filed disclosure.

5. The substitute specification filed 11/25/02 has not been entered because it does not conform to 37 CFR 1.125(b)(1) because it is not accompanied by a statement that the substitute specification contains no new matter.

#### ***Claim Objections***

6. Claims 1 and 3 are objected to because of the following informalities: These claims contain misspelled words. Specifically, "sown" should read as "sewn", "devise" should read as "device", and "devises" should read as "devices". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

7. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment to the claims adds new matter into the claims, this new matter not being described in the application as originally filed.

The new matter which is added to the claims by the amendment filed 11/25/02 is as follows: (1) The recitation in claim 1 that the back piece is sewn to two front pieces with one front piece sewn on one side of the back piece and the other sewn on the remaining side of the back piece. Although the figures show two front pieces extending from the back and attaching to each other by buttons or a zipper, it is not disclosed that these front pieces are separate pieces which are attached to the back piece (they could be integral with one of the back pieces) and it is not disclosed that they are *sewn* to the back piece. (2) The recitation of a "rope-like" article. This element was previously disclosed as "straps 21" or a drawstring which extends through the loop 22. The figures and the specification as originally filed does not provide support for the claim recitation of these elements being "rope-like".

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

With regard to claim 1, this claim should be one complete sentence. It should not end with a colon and continue into claim 2.

Claim 2 recites “the shoulder area” without antecedent basis. Also, claim 2 is confusing in reciting “a sack portions” since “a” is singular and “portions” is plural. Claim 2 should be one sentence long, rather than two sentences.

Claim 3 recites “said mouth opening” without antecedent basis. Also, the term “sack portion” in line 2 should be preceded with “a”. Claim 3 recites “the smooth uninterrupted surface” without antecedent basis.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yellen et al (US 4,068,314).

Yellen et al disclose a jacket comprising two large sheets of material (14,16) forming a back piece which is attached to two front pieces, with one at each side of the back piece as claimed (see Figs. 1-2). Yellen discloses that the garment pieces may be sewn together (col. 2, line 60; col. 3, lines 5-19), as recited in claim 1. The pieces form a “trunk-like” structure which includes a head/neck opening and two long sleeves (Figs. 1-2) as claimed. The jacket includes a panel of buttons (integral with front left panel; Fig. 2) and an opposing separate panel of button holes (integral with right front side as shown in Fig. 2; see col. 2, lines 62-63) for closing the trunk portion.

Regarding the recitation in claim 1 of the garment being a "combination reversible and convertible article", it is noted that the garment of Yellen is such an article since it is clearly capable of being turned inside out and is convertible to a backpack use by filling the storage pack 12 with items and using the straps 32. The garment is useful as a jacket and as a tote bag (by filling the storage pack 12 with items).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loscher (US 2,711,539).

Loscher discloses a reversible jacket comprising two large sheets of material forming a back piece (see, e.g., Fig. 3 or 4, where the inner fabric forms one sheet and the outer fabric forms the second sheet). The back piece is attached to two front pieces, with one at each side of the back piece as claimed, forming a "trunk-like" structure which includes a head/neck opening and two long sleeves (59 in Fig. 3 or 74 in Fig. 4). The jacket includes a panel of buttons (71) and a separate panel of button holes (67 or 78).

Thus, Loscher discloses all of the structure as recited in claim 1 except that the back and front panels are not specifically disclosed as sewn together. In Figs. 3 and 4,

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the seams where the front panels are attached to the back panel are shown at the sides (above and below the sleeve holes), this seam being depicted as a solid line. Although they appear from the figures to be sewn seams, Loscher does not specifically disclose that they are sewn together. Fabric panels of garments are conventionally sewn together in order to attach the panels in a secure and convenient manner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the front and back panels in the garment of Loscher by sewing, since the Examiner takes Official Notice that sewing is a conventional means to attach garment fabric panels together in order to provide a secure, durable connection which is easily and economically formed.

Regarding the recitation in claim 1 of the garment being a "combination reversible and convertible article", it is noted that the garment of Loscher is such an article since it is reversible and is convertible (from one fabric pattern to the other), and is a "combination" garment since it is two jackets in one due to its reversible nature (Fig. 3 or 4) and due to the two jackets forming the combination jacket (Fig. 6) being separable. The recitation that the claimed invention is "useful as a jacket and tote bag in one" is drawn to the use of the device and does not define any actual structure. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



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14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loscher (US 2,711,539) in view of Ito (US 6,116,175).

Loscher discloses a jacket including a reversible side allowing the user to conceal all openings leading to a sack portion, the sack portion being shown at 68 or 79 in Figs. 3 and 4. The mouth opening leading to the sack portion (68 or 70) is thus protected as claimed. An "optional look" is present by reversing the jacket, which includes a fastening track and slider (see zipper fasteners 65 or 77 in Figs. 3, 4, 6) as claimed. The jacket has a smooth uninterrupted surface at the back as claimed.

Thus, Loscher discloses all of the structure as recited in claim 3 except that the claimed interlock stitching is not disclosed. Interlock stitching is a conventional type of stitching used in the apparel art, however, such as disclosed by Ito. Ito discloses a conventional sewing technique (col. 1, lines 23-29) which includes use of interlock stitching to attach two pieces of cloth together. Ito teaches that this technique eliminates risk of puckering in a sewing portion and eliminates threads breaking at the first stitches (col. 1, lines 33-35). Ito also discloses an improvement on this prior art method, the improvement also including the use of interlock stitching to attach two pieces of cloth (see, e.g., Fig. 1(a)). Ito teaches that the sewing technique may be used on jackets and parkas which are for outdoor use (col. 10, lines 13-1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to stitch the sleeves, collar, borders, and other seamed areas of the jacket of Loscher with interlock stitching, such as taught by Ito, in order to decrease the risk of puckering and thread breakage.

15. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi (US 4,502,154) in view of Yellen et al (US 4,068,314).

Itoi discloses a jacket comprising two large sheets of material (14 and 1D) forming a back piece. The back piece is attached to two front pieces, with one at each side of the back piece as claimed (Fig. 1), forming a “trunk-like” structure which includes a head/neck opening and two long sleeves (1B). The back and front panels are not specifically disclosed as sewn together, although they appear from the figures to be sewn together. Fabric panels of garments are conventionally sewn together in order to attach the panels in a secure and convenient manner. Yellen teaches that the pieces of a jacket are conventionally sewn together (col. 2, line 60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the front and back panels in the garment of Itoi by sewing, such as taught by Yellen, since sewing is a conventional means to attach garment fabric panels together in order to provide a secure, durable connection which is easily and economically formed.

Regarding the recitation in claim 1 garment being a “combination reversible and convertible article”, it is noted that the garment of Itoi is such an article since it is clearly capable of being turned inside out and is convertible to a tote bag. The jacket of Itoi is “useful as a jacket and tote bag in one” as recited in claim 1 (see Figs. 1 and 6 of Itoi).

Itoi also does not disclose that the jacket has buttons and buttonholes for closing the front of the jacket, as in claim 1. Jackets are conventionally provided with such fasteners in order to hold the garment closed, as shown by Yellen et al (see col. 2, lines 62-63 and Fig. 2). It would have been obvious to one having ordinary skill in the art at

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the time the invention was made to provide mating panels of buttons and buttonholes on the front of the jacket of Itoi in order to attach the front right and left panels to each other for closing the garment, for the warmth and comfort of the wearer, as shown by Yellen.

Regarding claim 2, Itoi shows one sheet of the back of the jacket as having a smooth surface (14) and the other sheet (1D) as having a surface which is interrupted by a mouth opening (2). The mouth opening (2) leads to a sack portion (7), which when inverted can hold the jacket to transform the jacket into a tote bag (Figs. 4-5) as claimed. The mouth opening (2) has a loop (5) along the opening which receives a rope-like article (3 or 4) which can be used to carry the tote bag as claimed. Itoi does not show the mouth opening (2) as positioned across the shoulder area, but rather shows it lower down on the garment (see Fig. 2). It is known, however, to position attached storage bag openings higher up on the jacket, across the shoulder area, such as shown by Yellen. This would allow the pouch to be larger, since the inner side of pouch 7 as seen in Fig. 3 of Itoi could be longer if the opening 2 were positioned higher up on the jacket back. Also, one having ordinary skill in the art may choose to position the opening higher up on the jacket merely as a matter of preference, comfort, or aesthetics. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pouch opening across the shoulder region of the jacket of Itoi rather than in the middle back region, such as shown by Yellen et al, in order to provide a larger pouch, or merely as a matter of aesthetics or comfort.

16. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skiles, Jr. (US 5,010,592) in view of Yellen et al (US 4,068,314).

Skiles discloses a jacket comprising two large sheets of material (see Fig. 3) forming a back piece. The back piece is sewn to two front pieces of a standard jacket, with one at each side of the back piece as claimed (Fig. 4 and col. 4, lines 25-28), forming a "trunk-like" structure which includes a head/neck opening and two long sleeves (Fig. 4). Regarding the recitation in claim 1 garment being a "combination reversible and convertible article", it is noted that the garment of Skiles is clearly capable of being turned inside out (see col. 2, line 64) and is convertible to the bag shown in Fig. 11. The jacket of Skiles is "useful as a jacket and tote bag in one" as recited in claim 1 (see Fig. 4 and 11 of Skiles).

Skiles does not disclose that the jacket has buttons and buttonholes for closing the front of the jacket, as in claim 1. Jackets are conventionally provided with such fasteners in order to hold the garment closed, as shown by Yellen et al (see col. 2, lines 62-63 and Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide mating panels of buttons and buttonholes on the front of the jacket of Skiles in order to attach the front right and left panels to each other for closing the garment, for the warmth and comfort of the wearer, as shown by Yellen.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skiles, Jr. (US 5,010,592) in view of Yellen et al (US 4,068,314), as applied to claim 1 above, and further in view of Itoi (US 4,502,154).

Skiles, modified in view of Yellen et al, discloses a jacket as claimed in claim 1. One sheet of the back of the jacket of Skiles has a smooth surface (21, or the back of the body B the jacket C into which the liner is shown) and the other sheet as having a surface which is interrupted by a mouth opening (O). The mouth opening (O) is positioned across the shoulder area (see Fig. 4) and leads to a sack portion (P), which when inverted can hold the jacket to transform the jacket into a bag (Figs. 11) as claimed. The mouth opening (O) is disclosed as closed by means of fasteners 80, 81 which comprise Velcro hook and loop strips, rather than by a rope-like drawstring fastener. Itoi, however, shows such a rope-like drawstring fastener for the opening (2) which leads into the sack portion (7) for holding the attached jacket (see Fig. 2 of Itoi). The mouth opening (2) of Itoi has a loop (5) along the opening which receives a rope-like article (3 or 4) which can be used to close the opening and to carry the tote bag as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pouch opening of Skiles with a rope-like drawstring rather than Velcro fasteners, such as shown by Itoi, in order to provide a closing means which can also be used as a carrying handle.

### ***Response to Arguments***

18. Applicant's arguments filed 11/25/02 have been fully considered but they are not persuasive with regard to Itoi (4,502,154). Applicant argues that Itoi (4,502,154) does

not disclose a jacket which is reversible. The recitation in the claims of the jacket being reversible, however, does not define any actual structure over that of Itoi '154. This recitation merely requires the ability to be reversed, or the capability of being turned inside out, which capability the jacket of Itoi '154 clearly has. There is nothing in the structure of Itoi '154 which would prevent the reversing of the jacket by turning it inside out. The claims recite no further structure with regard to the reversibility which would define the claimed invention over that of Itoi.

19. Applicant's arguments with respect to claims 1-2 regarding DeLott and 4,502,155 to Itoi have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy B. Vanatta whose telephone number is 703-308-2939. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Amy B. Vanatta  
Primary Examiner  
Art Unit 3765